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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048667
Party	Defendant Peter Baumberger
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Submission	Motion to Strike
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Signature	/Annie C. Haselfeld/
Date	05/06/2009
Attachments	Reply.pdf (6 pages)(26082 bytes) Second Declaration.pdf (2 pages)(14561 bytes) Exhibit A.pdf (3 pages)(126706 bytes) Exhibit B.pdf (6 pages)(142355 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Jules Jurgensen/Rhapsody, Inc.,)	
)	Cancellation No: 92048667
Petitioner,)	
)	Registration No.: 3,181,224
v.)	
)	
Peter Baumberger,)	
)	
Respondent.)	
_____)	

**REPLY TO PETITIONER’S BRIEF IN RESPONSE TO
MOTION TO STRIKE TESTIMONY OF MORTON CLAYMAN**

I. INTRODUCTION

During Petitioner’s trial period, Petitioner took the deposition of Morton Clayman, an undisclosed witness. Petitioner never identified Mr. Clayman as a potential witness in its initial disclosures, in supplemental initial disclosures, or pretrial disclosures, a fact that Petitioner does not deny. The first time Petitioner ever identified Mr. Clayman was in Interrogatory Responses served *after* the close of the discovery period. The Federal Rules of Civil Procedure and the Board’s rules require litigants to disclose the identity of potential witnesses and subject matter on which they may testify. As a result of Petitioner’s failure to follow the rules, Respondent has been deprived of the opportunity to adjust its discovery and trial strategy and to adequately prepare for the testimony deposition. Absent substantial justification or proof that the failure to disclose was harmless, undisclosed witnesses may not testify at trial. The party who failed the disclose the information bears the burden of proving that its failure was justified or harmless. In this case, Petitioner fails to meet its burden since it has

offered absolutely no competent or admissible evidence that its failure to disclose was harmless or justified.

II. ARGUMENT

A. Petitioner Does Not Deny it Failed to Disclose Mr. Clayman in its Initial and Pretrial Disclosures.

Petitioner failed to follow the disclosure rules laid out in the Federal Rules of Civil Procedure and by the Trademark Trial and Appeal Board. In fact, in Petitioner's Response to the Motion to Strike, Petitioner does not deny that it failed to submit adequate initial and pretrial disclosures. The Federal Rules of Civil Procedure and the Board's rules clearly require parties to disclose the name of each individual likely to have discoverable information in both initial disclosures and pretrial disclosures. Fed. R. Civ. P. 26(a)(1)(A); 37 C.F.R. § 2.120; 37 C.F.R. § 2.121(e). Additionally, the Board's rule regarding pretrial disclosures requires not only the name of any potential witness, but also identifying information such as relationship to any party, job title, occupation, and a general summary of subjects on which the witness is expected to testify. 37 C.F.R. § 2.121(e). None of this information regarding Mr. Clayman was ever disclosed to Respondent, and Petitioner does not deny that fact.

B. Petitioner Has Not Met its Burden of Proving That its Failure to Disclose was Justified or Harmless.

"A party that without substantial justification fails to disclose information required by Rule 26(a) or 26(e)(1), is not, unless such failure is harmless, permitted to use as evidence at a trial, at a hearing or on a motion any witness or information not so disclosed." Fed. R. Civ. P. 37(c)(1); *Go Medical Indus.*, 300 F. Supp. 2d 1208 (N.D. Ala. 2004). The burden of establishing that nondisclosure is substantially justified or

harmless rests upon the party who failed to disclose the information. *Finley v. Marathon Oil Co.*, 75 F.3d 1225, 1230 (7th Cir. 1996); *Cooley v. Great Southern Wood Preserving*, 138 Fed. Appx. 149, 161 (11th Cir. 2005); *Burney v. Rheem Mfg'g Co., Inc.*, 196 F.R.D. 659, 691 n. 29 (M.D. Ala. 2000). Here, Petitioner has failed to meet its burden, as it has offered no evidence at all of harmless error or justification - only attorney argument. Not one factual allegation set forth in Petitioner's opposition to the Motion is supported by admissible, competent evidence in the form of a declaration or otherwise. Therefore, under the Board's rules, these factual allegations cannot be considered. T.B.M.P. 704.06(b); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1462 n.5 (TTAB 1992) (additional revenue figures provided in trial brief not considered); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819, 823 (TTAB 1981) (factual statements regarding certain scientific matter which cannot be deemed to be public knowledge not considered).

Even if the Board considered Petitioner's unsupported attorney argument, this argument does not provide substantial justification for Petitioner's failure to follow the rules or its contention that its non-disclosure was harmless. Rather, due to Petitioner's failure to disclose, Respondent was deprived of any knowledge regarding the substance of Mr. Clayman's testimony. In fact, during Mr. Clayman's deposition, Petitioner's attorney actually sought to qualify Mr. Clayman as an expert in the sales and marketing of watches, despite the fact that Mr. Clayman was never disclosed in expert disclosures nor did he provide an expert report as required Fed. R. Civ. P. 26(a)(2) and 37 C.F.R. § 2.120. (Second Haselfeld Decl. ¶ 2, and Ex. A thereto).

Respondent also relied on Petitioner's lack of initial and pretrial disclosure of witnesses to indicate that Petitioner intended to introduce only documentary evidence at trial and not witness testimony. Respondent would have considered different discovery and trial strategies had Petitioner properly disclosed Mr. Clayman's identity. However, by the time Petitioner ever identified Mr. Clayman as a potential witness in its Responses to Respondent's Interrogatories, it was well after the close of the discovery period. (Second Haselfeld Decl. ¶ 3, and Ex. B thereto).

C. The Cases Cited By Petitioner Do Not Indicate That its Failure To Disclose was Justified or Harmless.

The cases cited by Petitioner do not support its argument that the failure to disclose was harmless or justified. For example, *Entex Industries, Inc. v. Milton Bradley Co.*, 213 U.S.P.Q. 1116 (TTAB 1982), does not relate to the issue of disclosures at all. In that case, the applicant's counsel instructed the witness to refrain from answering opposing counsel's questions. Opposer moved to strike the testimony, and although the Board denied the motion to strike, it presumed that the answers to the questions would have been adverse to the party whose witness refused to answer. *Id.* at 1117. Therefore, nothing in the case supports Petitioner's argument that failure to disclose Mr. Clayman's testimony was justified or harmless.

Similarly, *Coleman v. Keebler Co.*, 997 F. Supp. 1102, 1107 (N.D. Ind. 1998), is not relevant since it involves the disclosure of witnesses during a deposition. In *Coleman*, disclosure occurred during the testimony period, when there was still an opportunity to take discovery of the witnesses. In this case, however, Petitioner disclosed Mr. Clayman's identify for the first time in late interrogatory answers served after the close of discovery.

Petitioner also cites *Mawby v. U.S.*, 999 F.2d 1252 (8th Cir. 1993), a case in which the appellate court did not find an abuse of discretion in allowing surprise expert witness testimony. However, the appellate court also stated that the failure to disclose the witness' testimony was a clear violation of the federal rules and that this was not the way trial should be conducted. *Id.* at 1254. Therefore, none of the cases cited by Petitioner's counsel in favor of admitting the testimony of Mr. Clayman are relevant.

III. CONCLUSION

For the reasons set forth above and in its Motion to Strike Testimony of Morton Clayman, Respondent respectfully requests that the Board strike the testimony of Morton Clayman in its entirety.

Respectfully submitted,



Dated: May 6, 2009

Andrea Anderson
Annie Chu Haselfeld
Holland & Hart LLP
One Boulder Plaza
1800 Broadway, Suite 300
Boulder, CO 80302

**ATTORNEYS FOR RESPONDENT
PETER BAUMBERGER**

CERTIFICATE OF SERVICE

The undersigned certifies that the attached **REPLY TO PETITIONER'S BRIEF
IN RESPONSE TO MOTION TO STRIKE TESTIMONY OF MORTON**

CLAYMAN was served on the below-identified counsel for Petitioner on May 6, 2009
by the means indicated below

- ☒ U.S. Mail, postage prepaid
☒ Email
☐ Hand Delivery

Stuart E. Beck
THE BECK LAW FIRM
1500 Walnut Street, Suite 700
Philadelphia, PA 19102-3504
BeckPatent@aol.com

Annie C. Haselfeld

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Jules Jurgensen/Rhapsody, Inc.,)	
)	Cancellation No: 92048667
Petitioner,)	
)	Registration No.: 3,181,224
v.)	
)	
Peter Baumberger,)	
)	
Respondent.)	
_____)	

SECOND DECLARATION OF ANNIE CHU HASELFELD

I, Annie Chu Haselfeld, declare as follows:

1. I am an attorney for Holland & Hart LLP, and I am one of the attorneys of record for Respondent Peter Baumberger in this proceeding. I make this declaration based on personal knowledge.

2. On March 18, 2009, Petitioner took the testimony deposition of Morton Clayman. Petitioner's attorney sought to qualify Mr. Clayman as an expert in the sales and marketing of watches. Attached hereto as Exhibit A is a true and correct copy of deposition transcript excerpts from Morton Clayman's deposition dated March 18, 2009.

3. On December 17, 2008, Petitioner identified Mr. Clayman in its Responses to Respondent's Interrogatories, two months after the discovery period closed on October 4, 2008. Attached hereto as Exhibit B is a true and correct copy of Petitioner's Responses to Respondent's Interrogatories dated December 17, 2008.

I declare under penalty of perjury that the foregoing is true and correct.

DATED this 6th day of May, 2009.

A handwritten signature in cursive script, reading "Annie C. Haselfeld".

Annie Chu Haselfeld

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IN THE UNITED STATES PATENT AND MARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JULES JURGENSEN / :
RHAPSODY, INC., : CANCELLATION NO.
 : 92-048667
Petitioner, :
 : REGISTRATION NO.
- vs - : 3181224
 :
PETER BAUMBERGER, :
 :
Respondent. :

Trial deposition of MORTON CLAYMAN,
taken at the offices of Jules Jurgensen, 101
West City Avenue, Bala Cynwyd, Pennsylvania,
on Wednesday, March 18, 2009, commencing at
9:54 a.m., before EMILIE S. POSNAN,
Professional Reporter-Notary Public, there
being present.

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1 A. Absolutely.

2 Q. And in the course of your activities in the
3 watch industry, do you study brand names and which
4 brand names are associated with which vendors?

5 A. I do and try my best.

6 Q. In the course of your activities in the
7 watch industry, do you study ways to sell watches to
8 customers and potential customers?

9 A. Yes.

10 Q. And is it true that you do this on a regular
11 basis?

12 A. Yes.

13 Q. For how long have you done this?

14 A. Since I've been in the watch business.

15 Q. Would it be correct to say that you are
16 knowledgeable about the sales and marketing of
17 watches?

18 A. I hope so, yes.

19 MR. BECK: I move that Mr. Clayman
20 be qualified as an expert in the sales and
21 marketing of watches.

22 BY MR. BECK:

23 Q. How long have you, as Jules Jurgensen /
24 Rhapsody, been selling watches under the --

1 MS. ANDERSON: I'm sorry; I need to
2 interpose an objection. I'm going to object
3 to the qualification of Mr. Clayman as an
4 expert witness on issues related to the
5 sales of watches. Obviously, as a
6 layperson, he is qualified to testify as to
7 matters within his personal knowledge that
8 he's witnessed, but I don't know that we've
9 had a showing adequate of expert status in
10 this particular category.

11 Moreover, there hasn't been an
12 expert report entered. Mr. Clayman has not
13 been identified as an expert either in
14 initial disclosures or in pretrial expert
15 disclosures. Sorry for the long objection.
16 Please proceed, sir.

17 BY MR. BECK:

18 Q. How long have you, as Jules Jurgensen /
19 Rhapsody, been selling watches under the trademark
20 Jules Jurgensen?

21 A. Since we purchased this, I think it was July
22 25th, 1974.

23 Q. I'm going to show you a 40-page document
24 that has been previously marked as P-0011.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Jules Jurgensen/Rhapsody, Inc.,

Petitioner,

v.

Peter Baumberger,

Respondent.

Cancellation No. 92048667

PETITIONER'S RESPONSE
TO
RESPONDENT'S FIRST SET OF INTERROGATORIES

Petitioner responds to Respondent's First Set of Interrogatories, as follows:

PRELIMINARY STATEMENT AND GENERAL OBJECTIONS

1. Petitioner objects to each and every definition, instruction, and Interrogatory to the extent it purports to expand Respondent's discovery obligations beyond what is required by the Federal Rules of Civil Procedure and the rules of the United States Patent and Trademark Office.
2. Petitioner objects to each Interrogatory to the extent that it seeks information or documents that are protected by the attorney-client privilege or attorney work-product doctrine.

CERTIFICATE OF SERVICE
I CERTIFY THAT A COPY OF THIS PAPER WAS SENT BY FIRST
CLASS MAIL THIS 17th DAY OF Dec
2008. POSTAGE PREPAID TO THE LAST KNOWN ADDRESS
OF THE ATTORNEY OF RECORD FOR EACH OF THE PARTIES TO
THIS ACTION. By Fed EX

3. Petitioner objects to each Interrogatory to the extent it seeks confidential business information. Petitioner will provide such responsive information subject to the protections described in the protective order entered by the Trademark Trial and Appeal Board.
4. Petitioner reserves the right to supplement and/or amend its responses to these Interrogatories as discovery unfolds.
5. Petitioner reserves all rights to object to the competency, relevancy, materiality, and admissibility of the information disclosed pursuant to Respondent's Interrogatories.
6. Petitioner objects to all Interrogatories that ask Petitioner to identify "all documents" which refer or relate to a subject matter as being inherently overbroad, unduly burdensome, duplicative, vague and ambiguous, and seeking information that is irrelevant or not reasonably calculated to lead to the discovery of admissible evidence.
7. Petitioner objects to Respondent's definition of "You," "Your" or "Petitioner" to the extent it includes legally separate or distinct entities who are not parties to this cancellation action. Petitioner responds to these Interrogatories on behalf of itself and all persons or entities legally identified with Petitioner, including his officers, employees and agents, but not other parties or entities that are not legally identified with Petitioner.

The foregoing objections are incorporated by this reference into each separate response below as though set forth in full.

Responses:

Interrogatory No. 1:

Describe in detail the circumstances surrounding Petitioner's selection, clearance, and adoption of the Mark and any mark containing the term "JURGENSEN," including but not limited to the reasons that Petitioner selected the mark(s), when Petitioner selected and cleared the mark(s), and all persons involved in the selection and clearance of the mark(s).

Answer: Petitioner acquired the right to sell watches in then United States under the trademark JULES JURGENSEN from Downe Communications, a Delaware corporation and Jules Jurgensen Corp. a New York Corporation on July 25, 1974.

Interrogatory No. 1 (bis):

Describe in detail the circumstances surrounding Petitioner's alleged acquisition of rights in or license to use the Mark and any mark containing the term "JURGENSEN," including the date of the alleged acquisition(s) and/or license(s).

Answer:

Petitioner acquired the right to sell watches, springbars, bracelets, and containers in the United States under the trademark JULES JURGENSEN from Downe Communications, a Delaware corporation, and Jules Jurgensen Corp. a New York Corporation on July 25, 1974.

Interrogatory No. 2:

Identify each product and service with which Petitioner has used the Mark or any mark containing the term "JURGENSEN" from the first use of the mark(s) to the present, by stating for each such product and service:

- (a) The name of and the description of the product or service;

Answer:

Watches and spring bars, bracelets, containers for watches, spring bars and bracelets.

- (b) The date of first use of the mark(s) with each product or service;
(c) The time period(s) during which each such product or service was/is promoted, sold, or offered.

Watches and spring bars - From July 25, 1974 to the present

Bracelets - From July 25, 1974 to the present

Containers - From July 25, 1974 to the present

Interrogatory No. 3:

Identify the person(s) most knowledgeable about Petitioner's Products from the first use of the Mark or any mark containing the term "JURGENSEN" to the present.

Answer:

Morton Clayman
President
Jules Jurgensen/Rhapsody, Inc.
101 West City Line Avenue
Bala Cynwyd, PA 19004

Interrogatory No. 3 (bis):

Identify all documents related to assignments, transfer of rights in, or licenses to use the Mark or any mark containing the term "JURGENSEN".

Answer:

Agreement of Sale dated July 24, 1974.

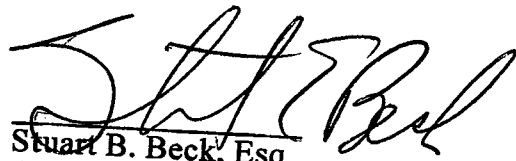
Interrogatory No. 4:

Identify each person who provided information in connection with Petitioner's Responses to Respondent's First Set of Interrogatories, and specify the Interrogatories for which each identified person provided information.

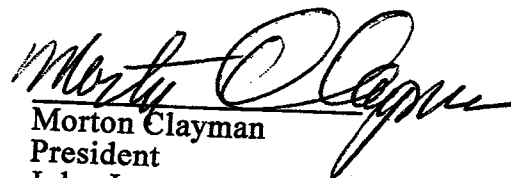
Answers:

Morton Clayman as to all of Petitioner's Responses to Respondent's First Set of Interrogatories,

As to Objections:


Stuart B. Beck, Esq.
Attorney for Petitioner

As to Answers


Morton Clayman
President
Jules Jurgensen/Rhapsody, Inc.